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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,992	12/06/2001	Lawrence W. Stark	018158-018610US	1090

20350 7590 03/29/2005

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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8h

<b>Office Action Summary</b>	<b>Application No.</b> 10/006,992	<b>Applicant(s)</b> STARK ET AL.	
	<b>Examiner</b> david shay	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on December 21, 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-20 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-20 and 36-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18-20 and 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seibel et al in combination with Odrich et al and Burns. Seibel et al teach a method such as claimed except the transmission through optical tissue, reflection from the retina and a plurality of beamlets. Burns teach a spatially resolved refractometer, which transmits images through the cornea and receives images reflected off the retina. Odrich et al teach mapping the surface contour of the cornea using a spatially resolved refractometer. It would have been obvious to employ the refractometer of Burns in the method of Odrich et al and to produce the contour data by the close integration path method of Seibel et al, since Odrich et al discusses no method to produce the contour data, thus producing a method such as claimed.

The rejection of claim 36 has been more clearly set forth.


Applicant argues that the examiners "rational to combine Odrich with Seibel (i.e. because Odrich fails to describe contour data is developed) is improper." The examiner must first point out that the rational for combination is in fact that "Odrich et al discuss no method to produce the contour data" (emphasis added, see the previous office action page 3, first paragraph). Applicant then asserts "that a reference fails to teach an element does not automatically provide a motivation to combine it with a reference that does teach the element." Applicants' assertion is first inaccurate because it is not simply a matter of the element not being taught, but the element being required for the apparatus or process described by the reference and the method and device for producing this necessary data not being taught thereby. Secondly, applicant has put forth no

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rationale and no authority upon which the assertion is based, and as a mere statement by applicant's representative, is not convincing.

Applicant's arguments filed December 21, 2004 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

Any inquiry concerning this communication should be directed to david shay at telephone number (571) 272-4773.

  
DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330